

REMARKS/ARGUMENTS

These remarks are made in response to the Office Action of December 10, 2008 (Office Action). As this response is timely filed within the 3-month shortened statutory period, no fee is believed due. However, the Examiner is expressly authorized to charge any deficiencies to Deposit Account No. 14-1437.

Response to Arguments

Applicants maintain that the present invention predates Hicks because Applicants conceived the present invention prior to Hicks and diligently pursued the present invention from a date prior to the effective date of Hicks to the constructive reduction to practice of the present invention, namely the filing of an application. However, in the interest of advancing the prosecution, Applicants make the following comments regarding the art rejections.

In addition, the Examiner has not demonstrated that the provisional applications 60/476,743 (filing date 06/06/2003) and 60/495,843 (06/23/2003) and the CIP application 10/614,744 (filing date 07/07/2003) of Hicks, which have a filing date earlier than the filing date of the instant application, actually contain the subject matter upon which the Examiner relied in rejecting the present invention.

Claims Rejections – 35 USC § 103

Claims 1-8 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Published Patent Application 2006/0019667 to Hicks, III (hereinafter Hicks), in view of U.S. Published Patent Application 2002/0006797 to Virtanen (hereinafter Virtanen).

Applicants respectfully disagree with the rejections and thus have not amended the claims. Claims 22-35 have been added. The added claims are fully supported by the original disclosure and no new matter has been introduced.

Aspects of Applicants' Invention

It may be helpful to reiterate certain aspects of Applicants' invention prior to addressing the cited references. One embodiment of the invention, as typified by Claim 1, is a method of roaming between mobile and wireless networks. The method can include detecting a wireless network in proximity to a mobile device; querying the wireless network for an Internet Protocol address for the mobile device; receiving the Internet Protocol address; and sending a message via a mobile network for the mobile device to a mobile switching center of the mobile network using a mobile network control channel, wherein the message instructs the mobile switching center to route voice data intended for the mobile device to the Internet Protocol address via a communicatively linked gateway and the wireless network. See, e.g., Specification, paragraphs [0026] to [0029]; see also Fig. 2.

Another embodiment of the invention, as typified by Claim 5, is a method of roaming between mobile and wireless networks. The method can include communicating over a wireless network using a mobile device; detecting that the mobile device is roaming outside a coverage area of the wireless network; and sending a message via a mobile network for the mobile device to a mobile switching center of the mobile network using a mobile network control channel, wherein the message instructs the mobile switching center to route voice data intended for the mobile device to the mobile device using at least one mobile voice channel of the mobile network. See, e.g., Specification, paragraph [0032].

The Claims Define Over The Prior Art

Wireless networks are becoming increasingly prevalent with thousands of so called hotspots being deployed throughout the United States, Europe, and Asia. A hotspot refers to the coverage area surrounding a wireless access point within which a device can communicate wirelessly with the access point. The access point typically includes a wireless transceiver and is connected to a packet-switched communications network such as the Internet. As such, the access point provides network connectivity to those devices capable of establishing a wireless communications link with the access point. Examples of hotspots or wireless networks can include those networks built around one of the 802 wireless communications protocols such as 802.11, 802.16, 802.20, and 802.15. See Specification, paragraph [0002].

While users may be able to roam between a limited number of hot spots while maintaining connectivity with a communications network, most wireless networks are not yet connected together. More often than not, users are unable to seamlessly roam from one 802.xx network to another. Such wireless networks largely function as data networks and are maintained independently of mobile communications networks. In the usual case, voice communications are not carried over such networks. In consequence, the voice capability of mobile networks has yet to be integrated with wireless networks. Equally limiting is the lack of common billing and administration, particularly registration, authentication, and the like. What is needed is a way to provide users with a common experience, support, and billing when roaming. See Specification, paragraphs [0003]-[0004].

The present invention provides a method, system, and apparatus for allowing a mobile communications device user to roam between a mobile network and a wireless network. In particular, the present invention allows a mobile communications device to utilize a mobile network control channel to inform a mobile switching center of the

manner in which voice data intended for the mobile communications device is to be routed. Notably, the inventive arrangements of the present invention do not require "mobile IP addressing." This improves scalability by eliminating the potential congestion at a mobile IP server. See Specification, paragraph [0005].

One aspect of the present invention can include a method of roaming between mobile and wireless networks. The method can include detecting a wireless network, querying the wireless network for an Internet Protocol address for a mobile device, and receiving the Internet Protocol address. The method further can include sending a message to a mobile switching center of the mobile network using a mobile network control channel. The message instructs the mobile switching center to route voice data intended for the mobile device to the Internet Protocol address via a communicatively linked gateway and the wireless network. The mobile switching center can be configured to route voice data intended for the mobile device to the Internet Protocol address via the communicatively linked gateway and the wireless network. The method also can include receiving voice data from the gateway via the wireless network. In another embodiment, the mobile device can be in communication with a different wireless network or a mobile network prior to the detecting step. See Specification, paragraphs [0006]-[0008].

Another aspect of the present invention can include a method of roaming between mobile and wireless networks including communicating over a wireless network, detecting that a mobile device is roaming outside a coverage area of the wireless network, and sending a message to a mobile switching center of a mobile network using a mobile network control channel. The message can instruct the mobile switching center to route voice data intended for the mobile device to the mobile device using at least one mobile voice channel. Accordingly, the mobile switching center can be configured to route voice data intended for the mobile device to the mobile device via the at least one mobile voice channel. The method further can include receiving voice data from the mobile

switching center via the mobile network. See Specification, paragraphs [0009]-[0010].

Hicks discloses systems and methods for providing integrated wireless and wired data voice and data services via a dual mode telecommunications device. A communication directed to an address associated with a dual mode device is received. If the dual mode device is in range of a wireless access point connected to a wired data network, then a determination is made whether the address of the dual mode device is associated with an address of at least one other device associated with the wired data network. If the address of the dual mode device is associated with an address of at least one other device associated with the wired data network, then the communication is routed over the wired data network to the dual mode device and the at least one other device. See the Abstract.

Clearly, the subject matter of Hicks, which concerns a dual mode telecommunications device that can be used both as a wireless mobile telephone and a cordless telephone, has nothing to do with the subject matter of the present invention which concerns a method of roaming between mobile and wireless networks. It is noted that a cordless phone can only communicate with its associated base station and thus cannot roam from one wireless network to another wireless network as in the present invention.

Virtanen does not make up for the deficiencies of Hicks.

Accordingly, the cited references, alone or in combination, fail to disclose or suggest each and every element of Claims 1, 5, 22, 26, 29, and 33. Applicants therefore respectfully submit that Claims 1, 5, 22, 26, 29, and 33 define over the prior art. Furthermore, as each of the remaining claims depends from Claims 1, 5, 22, 26, 29, or 33 while reciting additional features, Applicants further respectfully submit that the remaining claims likewise define over the prior art.

Applicants thus respectfully request that the claim rejections under 35 U.S.C. § 103 be withdrawn.

CONCLUSION

Applicants believe that this application is now in full condition for allowance, which action is respectfully requested. Applicants request that the Examiner call the undersigned if clarification is needed on any matter within this Amendment, or if the Examiner believes a telephone interview would expedite the prosecution of the subject application to completion.

Respectfully submitted,

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